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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,931	11/26/2001	Nobuaki Hashimoto	103092.02	9980

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EXAMINER

LEE, HSIEN MING

ART UNIT	PAPER NUMBER
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2823

DATE MAILED: 12/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,931

Applicant(s)

HASHIMOTO, NOBUAKI

Examiner

Hsien-Ming Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-73 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 53-73 is/are rejected.
- 7) ☒ Claim(s) 70, 71 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: ____

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

On page 1, a **continuing data** is missing since the present application is a continuation of 09/589,353, which is a divisional of 09/271,336.

On page 11, at line 27, the description related to drawings is confusing because applicant submitted two different version of figures, i.e. both Figure 8 (submitted on 1/10/02) and Figures 8A and 8B (submitted with the application on 11/26/01). It is confusing to the Examiner as to whether the applicant intends to use either Figure 8 or Figures 8A and 8B.

In addition, on page 25, at line 22, "conductive member 218" should be -- conductive member 118 --. Appropriate correction is required.

Claim Objections

2. Claims 70 and 71 are objected to because of the following informalities:

Claim 70, line 2 and claim 71, line 2, changing "either of an insulating film and a printed substrate" into -- either of an insulating film **or of** a printed substrate -- is suggested.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 53-65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,097,610. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Patent (claim 1) disclose similar subject matter, including: (a) a substrate in which penetrating holes are formed (line 16), which is equivalent to the claimed limitation " a substrate having penetrating holes formed therein"; (b) a conductive member adhered on one side of said substrate by an adhesive material over a particular region of said one side including said penetrating holes (lines 18-20), which is equivalent to the claimed limitation " the substrate having a conductive member adhered on one side thereof by an adhesive material over a particular region of the one side including the penetrating holes"; and (c) a part of said adhesive material is interposed between internal wall surfaces forming said penetrating holes (lines 29-31), which is equivalent to the claimed limitation "a part of the adhesive material interposed in internal wall surfaces forming the penetrating holes."

In addition, claims 2, 3, 17, 7, 8, 10, 11, 19 and 20 of the Patent are equivalent to claims 54, 55, 58-65 and 56-57 of the instant application, respectively.

5. Claims 66-73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6 of U.S. Patent No. 6,340,606. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter as recited in claims 66, 70, 72, 67, 68, 69, 71 and 73 of the instant application are equivalent to that of claims 1, 3, 6, 8, 10, 11, 13 and 16 of the Patent, respectively.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 53, 54, 56, 58 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Imasu et al. (US 6,208,525).

In re claims 53, 54, Imasu et al. in Fig. 12 and related text expressly teach the claimed substrate, including the substrate 19 having penetrating holes 19A formed therein, the substrate 19 having a conductive member 15/13/10 adhered on one side thereof by an adhesive material 16 over a particular region of the one side including the penetrating holes 19A, a part of the adhesive material 16 interposed in internal wall surfaces forming the penetrating holes 19A, wherein a part of the adhesive material 16 enters and exists within the penetrating holes 19A.

In re claim 56, Imasu et al in related text also teach that the adhesive material 16 is an adhesive tape (i.e. sheet)(col.8, lines 1-4).

In re claim 58, Imasu et al. in Fig. 12 further teach that the conductive member 15/13/10 includes first 10 and second 15/13 portions, a part of the first portion 10 positioned over each of the penetrating holes 19A, the first portion 10 having a greater width than the second portion 15/13.

In re claim 64, Imasu et al in related text also inherently teach an anisotropic conductive material 16 having conductive particles dispersed in an adhesive 16 (col.8, lines 3-4).

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8. Claims 53 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Bertolet et al. (US 5,844,317).

Bertolet et al in Figs. 5 and 6b and related text expressly teach the claimed substrate, including the substrate 150/140/90/50 having penetrating holes 160 formed therein, the substrate 150/140/90/50 having a conductive member 180 adhered on one side thereof by an adhesive material 190 over a particular region of the one side including the penetrating holes 160, a part of the adhesive material 190 interposed in internal wall surfaces forming the penetrating holes 160, wherein a part of the adhesive material 190 enters and exists within the penetrating holes 160.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hsien-Ming Lee whose telephone number is 703-305-7341. The examiner can normally be reached on M-F (9:00 ~ 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0142 for regular communications and 703-305-0142 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Hsien Ming Lee
December 10, 2002